

- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|------------------------------|---|-----------------------------|
| In re Application of: | : | Before the Examiner: |
| Buxton et al. | : | Bonzo, Bryce P. |
| | : | |
| Serial No.: 10/553,018 | : | Group Art Unit: 2113 |
| | : | |
| Filing Date: August 31, 2006 | : | |
| | : | |
| Title: RECOVERY FROM | : | Lenovo (United States) Inc. |
| FAILURES WITHIN DATA | : | Building 675, Mail C-137 |
| PROCESSING SYSTEMS | : | 4401 Silicon Drive |
| | : | Durham, NC 27709 |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action having a mailing date of December 13, 2008, Applicants respectfully request the formal review of the legal and factual basis of the rejections in this case prior to the filing of an Appeal Brief. A Notice of Appeal is filed concurrently herewith.

REMARKS/ARGUMENTS

Claims 1-16 are pending in the Application. Claims 1-16 remain rejected under obviousness-type double patenting. Claim 16 remains rejected under 35 U.S.C. §101. Applicants respectfully traverse these rejections for at least the reasons stated below.

I. Claims 1-16 are improperly rejected under obviousness-type double patenting

The Examiner has rejected claims 1-16 based on obviousness-type double patenting in view of claims 1-23 of U.S. Patent No. 6,948,093 and in view of claims 1-47 of U.S. Patent No. 6,993,537. While the Examiner rejects claims 1-16 based on obviousness-type double patenting, the Examiner asserts that claims 1-23 of U.S. Patent No. 6,948,093 contain every element of claims 1-16 of the instant application and that claims 1-47 of U.S. Patent No. 6,993,537 contain every element of claims 1-16 of the instant application. However, upon review of claims 1-23 of U.S. Patent No. 6,948,093 and claims 1-47 of U.S. Patent No. 6,993,537, these claims clearly do not contain every element of claims 1-16 of the instant application.

For instance, claim 1 of U.S. Patent No. 6,948,093 states "An apparatus for backing up a plurality of data elements in a data processing system, wherein the data elements exist in an ordered plurality of states, the apparatus comprising: means for backing up data elements grouped by state, the order in which groups are backed up corresponding to the order of the states in which the data elements exist; and means for logging changes in data in the data processing system." How does this contain every element of claim 1 of the instant application ("A method for recovering a data repository from a failure affecting a primary copy of the data repository, including the steps of: maintaining a secondary copy of data sufficient to recover the primary copy of the data repository and data items held thereon; in response to a failure affecting the primary copy of the data repository, recreating a primary copy of the data repository from the secondary copy; using a restore process to restore data items to the primary copy from the secondary copy within a recovery unit of work, wherein data items restored to the primary copy of the data repository within the recovery unit of work are made inaccessible to processes other than the restore process until

commit of the recovery unit of work; prior to commit of the recovery unit of work, configuring the primary copy of the data repository to enable addition of data items to the data repository independent of said restore step and to enable processes other than the restore process to retrieve said independently added data items; and in response to successful completion of the restore step, committing the recovery unit of work including releasing said inaccessibility of the restored data")? The Examiner has not provided any explanation or provided any detail as to how the Examiner makes such a conclusion.

Neither has the Examiner provided any detail as to how the Examiner concludes that claim 1 of U.S. Patent No. 6,993,537 ("A method for recovering data in a database of database records, following a failure of a media containing said database, said data recovery using a backup of the database and a log of log records detailing any changes in the database which are not captured in the backup, the method comprising the steps of: replaying the log, starting with the most recent log record; determining for each successive log record, that relates to an operation on a database record, whether processing the log record will result in the most recent state of the corresponding database record, and if so, processing the log record; maintaining a list of each update and delete operation processed, and wherein the list is used in the determining step; and subsequently restoring additional data from the backup") contains every element of claim 1 of the instant application.

Since the analysis employed in an obviousness-type double patenting determination parallels the guidelines for a 35 U.S.C. §103(a) rejection, the factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. §103 are employed when making an obvious-type double patenting analysis. M.P.E.P. §804. However, the Examiner has not made any such inquiry. The Examiner has not made any factual inquiries (1) to determine the scope and content of a patent claim and the prior art relative to a claim in the application at issue; (2) to determine the differences between the scope and content of the patent claim and the prior art as determined in (1) and the claim in the application at issue; (3) to determine the level of ordinary skill in the art; and (4) to evaluate any objective

indicia of nonobviousness. M.P.E.P. §804. Any obviousness-type double patenting rejection should make clear the differences between the inventions defined by the conflicting claims—a claim in the patent compared to a claim in the application. M.P.E.P. §804. Further, any obviousness-type double patenting rejection should include reasons why a person of ordinary skill in the art would conclude that the invention defined in the claim in issue is an obvious variation of the invention defined in a claim in the patent. M.P.E.P. §804. The Examiner has not made clear the differences between the inventions claimed in the application and the claims in the cited patents. Consequently, in view of the foregoing, the Examiner has not provided a basis for an obviousness-type double patenting rejection of claims 1-16. Thus, the rejections of claims 1-16 under obviousness-type double patenting are improper.

Furthermore, the Examiner appears to not be determining the scope and content of the patent claim relative to a claim in the application at issue but instead appears to be relying upon the Specification of U.S. Patent Nos. 6,948,093 and 6,993,537. The disclosure of a patent cited in support of a double patenting rejection cannot be used as though it were prior art, even where the disclosure is found in the claims. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839, 1846 (Fed. Cir. 1992). Instead, the claims of the patent are used as the basis for a double patenting rejection. *Id.* Further, the Examiner cannot focus on particular steps or elements in a single claim of a patent as allegedly teaching multiple claims in the application at issue. Claims must be read as a whole in analyzing a claim of double patenting. *General Foods Corp. v. Studiengesellschaft Kohle mbH*, 23 U.S.P.Q.2d 1839, 1843 & 1845 (Fed. Cir. 1992). This is an improper analysis employed in an obviousness-type double patenting rejection. As stated above, the Examiner is to first determine the scope and content of the patent claim (claims in U.S. Patent Nos. 6,948,093 and 6,993,537) relative to a claim in the application at issue. That is, the Examiner is to compare each entire claim individually in the patent (U.S. Patent Nos. 6,948,093 and 6,993,537) relative to each claim in the application individually. In this manner, the Examiner would then be determining whether the invention defined by a claim in the patent (U.S. Patent Nos. 6,948,093 and 6,993,537) is merely an

obviousness variation of an invention claimed in the application at issue. Thus, the rejections of claims 1-16 under obviousness-type double patenting are improper.

II. Claim 16 is improperly rejected under 35 U.S.C. §101.

Claim 16 is directed to a computer program embodied in a compute readable medium. The Examiner simply states that claim 16 is directed to non-statutory subject matter under 35 U.S.C. §101 because the claim explicitly recites a computer program. To Applicants knowledge, computer programs are still patentable as has been established by numerous cases (e.g., *In re Beauregard*, 35 U.S.P.Q.2d 1383 (Fed. Cir. 1995); *In re Lowry*, 32 U.S.P.Q.2d 1031 (Fed. Cir. 1994); *In re Alappat*, 31 U.S.P.Q.2d 1545 (Fed. Cir. 1994)). Further, the Examiner makes a comment that the medium is not limited to a physical storage medium as the Specification discusses the Internet. The mere fact that the Specification discusses the Internet is not evidence that a computer readable medium is not a physical storage medium. The Specification (paragraph [0023]) clearly states that the program code is recorded on a recording medium. The Specification does not state that the storage medium is the Internet.

III. CONCLUSION:

Applicants again submit that the rejections of claims 1-16 under obviousness-type double patenting are improper. Applicants further submit that the rejection of claim 16 under 35 U.S.C. §101 is improper. Applicants respectfully request that this case be reopened and that the rejections be withdrawn and a timely Notice of Allowance be issued.

Respectfully submitted,

WINSTEAD P.C.

Attorneys for Applicants

By: 

Robert A. Voigt, Jr.
Reg. No. 47,159